

## REMARKS

In accordance with the Notice of Non-Compliant Amendment, claims 1-50 are identified as canceled, and previously submitted claims are renumbered as claims 51-84. Accordingly, claims 51-84 are pending with entry of this Amendment, which also includes Remarks from the prior Amendment that addressed the current rejections. For the Examiner's convenience, claim numbers in the remarks are amended to be consistent with new claims 51-84. Reconsideration and allowance of the application, as amended, are respectfully requested.

### **I. Withdrawn Rejections**

Applicant kindly acknowledges that all prior rejections are obviated. Office Action (p. 2). The following remarks are submitted in response to new rejections based on U.S. Patent No. 6,849,075 to Bertolero *et al.* (hereafter referred to as "Bertolero").

### **II. Claims Satisfy the Written Description Requirement**

All of the pending claims are rejected under 35 U.S.C. §112 as allegedly failing to comply with the written description requirement on the basis that "non-coagulative" as recited in independent claims 51, 60, 69 and 84 is not found or described in the specification. Whenever a written description issue arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. MPEP §2163.02. Applicant respectfully traverses the rejection.

The specification of the subject application describes a coagulation element and explains that tissue coagulation involves ablating or killing tissue. *See, e.g.*, col. 1, lines 12-20. The specification also describes a stimulation element, which different than a coagulative element, and explains "The surgical device may also be used in conjunction with tissue stimulation apparatus, such as pacing and recording apparatus, which supply power that stimulates (but does not coagulate) tissue. *See*, col. 7, lines 1-13 (emphasis added). *See also*, p. 23, lines 27-29 ("tissue stimulation energy is provided by a tissue stimulation apparatus 300 that is capable of providing a pulse of energy that stimulates (but does not coagulate) tissue," p. 29, lines 21-25 (stimulation and sensing electrodes are relatively small (too small to form a transmural myocardial lesion)); p. 33, line 25 - p. 39, line 4. It is also well understood, as noted above, that a coagulation element is different than a stimulation element and has different functionality compared to a stimulation element, hence their different names, functionally and applications as described in the specification.

Claims 51, 60, 69 and 84 include limitations that further differentiate a coagulation element and a stimulation element by reciting that the coagulation element is used “for ablating tissue.” *See, e.g.*, col. 1, lines 12-20; p. 19, line 28 - p. 23, line 17. Applicant respectfully submits that claims reciting “a non-coagulative stimulation element on the main body” satisfy the written description requirement and convey with clarity that Applicant possessed the invention now claimed, particularly considering that there is no requirement that a claim amendment must include exactly the same nomenclature as provided in the specification. MPEP §608.01(o). Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. §112 be withdrawn. If the rejection stands, Applicant respectfully requests clarification how “non-coagulative” fails to satisfy the written description requirement in view of the descriptions provided by the specification and there being no requirement that a claim amendment must include exactly the same nomenclature as provided in the specification.

### **III. Claims 51-80 and 84 are Novel Over Bertolero**

Independent claims 51, 60, 69 and 84 and respective dependent claims 52-59, 61-68, and 70-80 stand rejected under 35 U.S.C. §102(c) as allegedly being anticipated by Bertolero. Applicant respectfully submits that the cited reference cannot support a rejection of these claims as amended.

Bertolero fails to disclose, teach or suggest the structural combination of “the suction region being between the non-coagulative stimulation element and the stimulation energy sensing element” and “a connector located between the stimulation element and the stimulation energy sensing element” as recited in independent claims 51, 60 and 69. Bertolero also fails to disclose, teach or suggest “the suction region being between the non-coagulative means for stimulating tissue and the means for sensing stimulation energy” as recited in claim 84.

The Examiner takes the position that the tissue contacting surface 224 (of a tissue contacting member 102) described by Bertolero is a “main body” as recited in these claims, the suction apertures 212 form a “suction region,” the sensors 214 (col. 14, lines 41-63) are a “simulation” element and a “stimulation energy sensing” element and the trough 250 is a “connector.” Based on these assumptions and allegations, however, Bertolero cannot anticipate claims 51, 60, 69 and 84 since the suction apertures 212 are formed in the tissue contacting surface 224 of a tissue contacting member 102 in a line along an edge of the tissue contacting member 102. Bertolero (Fig. 2; col. 14, lines 1-18). Consequently, there is no suction aperture 212 on a tissue contacting member 102 that is between sensors 214. Moreover, trough 250 and

suction aperture 212 components of a tissue contacting member 102 are not between sensors 214.

Therefore, Applicant respectfully submits that independent claims 51, 60, 69 and 84 are novel over Bertolero. Dependent claims 52-59, 61-68, 70-80 incorporate the elements and limitations of respective independent claims 51, 60, 69 and 84 and, therefore, are also believed novel over Bertolero.

Further, Bertolero fails to disclose, teach or suggest “wherein the suction region comprises first and second suction ports and the connector is positioned between the first and second suction ports” as recited in claims 57 and 66. Fig. 2 of Bertolero shows a trough 250 (the alleged “connector”), but the suction apertures 212 are formed in a surface 224 of a tissue contacting member 102 as a line of apertures 212 along an edge of the tissue contacting member 102. Therefore, the trough 250 is not between first and second suction ports.

Bertolero also fails to disclose, teach or suggest “the stimulation energy sensing element is adjacent to the first suction port; and the stimulation element is adjacent to the second suction port” as recited in claims 58 and 67. Applicant notes that claims 51 and 60 also recite “a connector located between the stimulation element and the stimulation energy sensing element.” Thus, a simulation element and sensing element are on opposite sides of the connector, and a sensing element on one side of the connector is adjacent a first suction port, and a simulation element on the other side of the connector is adjacent to another suction port. Bertolero, in contrast, shows a line of suction apertures 212 along one edge of a tissue contacting member 102 and a line of sensors on one side of the trough 250 along the opposite edge of the tissue contacting member 102. Bertolero (Fig. 2).

In view of the above remarks, Applicant respectfully submits that the rejection of claims 51-80 and 84 under 35 U.S.C. §102(e) be withdrawn.

#### **IV. Claims 81-83 Are Patentable Over Bertolero**

Dependent claims 81-83 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Bertolero. Dependent claims 81-83 incorporate the elements and limitations of respective independent claims 51, 60 and 69 and, therefore, are also believed allowable.

Accordingly, Applicant respectfully requests that the rejection of dependent claims 81-83 under §103(a) be withdrawn.

**CONCLUSION**

Applicant respectfully requests entry of this Amendment, and submits that doing so will place the application in condition for allowance in view of the forgoing amendments and remarks. If there are any remaining issues that can be resolved by telephone, Applicant invite the Examiner to kindly contact the undersigned at the number indicated below.

Respectfully submitted,

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